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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,221	10/26/2001	Keiji Nakagawa	11519-003001	7882

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EXAMINER

LOPEZ, FRANK D

ART UNIT	PAPER NUMBER
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3745

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/004,221

Applicant(s)

NAKAGAWA ET AL.

Examiner

F. Daniel Lopez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Response to Amendment***

Applicant's arguments filed March 28, 2003, have been fully considered but they are not deemed to be persuasive.

Applicant's arguments with respect to claims 1-4 and 11 have been considered but are deemed to be moot in view of the new grounds of rejection. The new grounds of rejection are necessitated by the added limitations concerning the burr.

Applicant argues that applicant's admitted prior art (fig 7) does not show an inner wall surface of the through hole, nearby a part where the communicating hole communicates with the through hole is in the shape of a flat surface. Applicant is mistaken. In comparing the through hole 33 in figures 7 and 1, it is understood that they have similar shapes. In figure 1, through hole has a curved front portion, and a flat surface adjacent the curved portion. This flat surface is nearby the communicating hole, which extends through the curved portion.

Applicant argues that neither applicant's admitted prior art, Injection Moulding Design, Japan 2-28134 nor German 3932248 discloses that a burr projects out from the communicating hole into the through hole. This is correct. But the combination of applicant's admitted prior art and Injection Moulding Design would necessarily result in a burr projecting out from the communicating hole into the through hole.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Drawings***

The drawings are objected to because figure 7 must be separated into figures 7A (for the larger drawing) and 7B (for the smaller drawing showing details of the larger drawing). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Figures 7A and 7B should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter. Note, for example, on page 3 line 27 "but" should be --by--.

### ***Claim Rejections - 35 USC § 112***

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. For example, in claim 2 line 2-3 "a groove making said inner wall surface nearby a part" should be --said inner wall surface includes a groove formed near a part--.

Claims 7 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 7 line 2 "said inner wall surface" has no antecedent basis.

### ***Double Patenting***

Applicant is advised that should claims 1; 2-4; and 11 be found allowable, claims 5 and 6; 7-9; and 12 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 102***

Claims 10 and 13 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Applicant's admitted prior art (see response to arguments above).

***Claim Rejections - 35 USC § 103***

Claims 1, 2, 5-7, 11, 12, 14 and 15 are rejected under 35 U.S.C. § 103 as being unpatentable over Applicant's admitted prior art in view of Injection Moulding Design. Applicant's admitted prior art discloses a master cylinder including a resin piston, method of making the resin piston and die for molding the resin piston, wherein the piston comprises a concavity (31) communicating with a through hole (32) by a communicating hole (33), wherein the piston is injected molded by first and second dies (11, 12) each including a corresponding core (15), with the through hole formed by the corresponding cores; and the concavity and communication hole is formed by a concavity core (13) abutting a flat surface of the corresponding cores (see detail of fig 7); wherein a groove forming an inner wall surface of the through hole, near the communication hole, has a flat surface; but does not disclose that the concavity core is inserted into an impact hole in the corresponding cores.

Injection Moulding Design teaches, for a piece formed by injection molding, using two dies and a core (fig 9.6b), that a tip of the core is inserted into an impact hole of the dies, for the purpose of preventing the core from damage (page 237 paragraph 3).

Since Applicant's admitted prior art and Injection Moulding Design are both from the same field of endeavor, the purpose disclosed by Injection Moulding Design would have been recognized in the pertinent art of Applicant's admitted prior art. It would have been obvious at the time the invention was made to one having ordinary skill in the art to insert a tip the concavity core of Applicant's admitted prior art into an impact hole in the corresponding cores, as taught by Injection Moulding Design, for the purpose of preventing the core from damage.

Claims 3 and 8 are rejected under 35 U.S.C. § 103 as being unpatentable over Applicant's admitted prior art in view of Injection Moulding Design, as applied to claims 2 and 7, respectively, above, and further in view of Japan 2-28134. The modified applicant's admitted prior art discloses all of the elements of claims 3 and 8, but does not disclose that the width of the groove is narrower than that of the through-hole and wider than a diameter of a stop pin.

Japan 2-28134 teaches, for a master cylinder resin piston including a communicating hole (24) communicating with a through hole (15), and a groove (lower section of through-hole, see fig 5) forming an inner wall surface of the through hole, near the communication hole, has a flat surface (15c); that the width of the groove is narrower than that of the through-hole (i.e. upper part of the through-hole) and wider than a diameter (23) of the stop pin (22).

Since the through-holes of Applicant's admitted prior art and Japan 2-28134 are functionally equivalent in the piston art; it would have been obvious at the time the invention was made to one having ordinary skill in the art to form the width of the groove of the modified Applicant's admitted prior art narrower than that of the through-hole and wider than a diameter of the stop pin, as taught by Japan 2-28134, , as a matter of engineering expediency.

Claims 4 and 9 are rejected under 35 U.S.C. § 103 as being unpatentable over Applicant's admitted prior art in view of Injection Moulding Design, as applied to claims 1 and 5, respectively, above, and further in view of German 3932248. The modified applicant's admitted prior art discloses all of the elements of claims 4 and 9, but does not disclose that the through-hole includes a projecting part for preventing a stopper pin from touching an inner wall surface near a part communicating with the communicating hole.

German 3932248 teaches, for a master cylinder piston including a concavity (42) communicating with a through hole (34) by a communicating hole (48); that the through-hole includes a projecting part (upper part of right side of piston 12, in fig 2) for preventing a stopper pin (38) from touching an inner wall surface near a part communicating with the communicating hole.

Since Applicant's admitted prior art and German 3932248 are both from the same field of endeavor, the purpose disclosed by German 3932248 would have been recognized in the pertinent art of Applicant's admitted prior art. It would have been obvious at the time the invention was made to one having ordinary skill in the art to make the through-hole of Applicant's admitted prior art with a projecting part, as taught

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by German 3932248, for the purpose of preventing a stopper pin from touching an inner wall surface near a part communicating with the communicating hole


**Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Lopez whose telephone number is (703) 308-0008. The examiner can normally be reached on Monday-Thursday from 6:30 AM -4:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ed Look, can be reached on (703) 308-1044. The fax number for this group is (703) 872-9302. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0861.



F. Daniel Lopez  
Primary Examiner  
Art Unit 3745  
June 04, 2003